

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 1-37 were pending in this application. Claim 36 has been cancelled by this reply without prejudice or disclaimer. Claims 1, 8, and 18-20 are independent. The remaining claims depend, directly or indirectly, from independent claims 1, 8, and 20.

Additional Claim Fees

The Applicant previously, by mistake and without deceptive intent, only paid for four (4) independent claims instead of five (5) independent claims. The fee for additional independent claim has been included with this reply.

Claim Amendments

Independent claim 1 has been amended to clarify that the optical disk includes encrypted data and that a cryptoprocessor, located on the optical disk, is configured to decrypt the encrypted data. Independent claims 8 and 18-20 have been amended in a similar manner. Support for the aforementioned amendment may be found, for example, in Figure 1-5 and the corresponding text in the present application.

Claims 11 and 25 have been amended to clarify that the cryptoprocessor decrypts (*i.e.* applies a decryption algorithm to) both encrypted and non-encrypted data on the optical disk.

Support for the above amendment may be found, for example, on page 11, line 31- page 12, line 40 and Figure 10 on the present application.

In addition, claims 1-35 and 37 have been amended to clarify various informalities in the claims as well as to address antecedent basis issues arising from the aforementioned amendments to the independent claims. No new matter has been added by any of the aforementioned amendments.

Rejections Under 35 U.S.C. § 112

Claims 11 and 25 have been rejected from failing to comply with 35 U.S.C. § 112, ¶1. The rejection is respectfully traversed. Claims 11 and 25 have been amended to clarify that the cryptoprocessor decrypts both encrypted and non-encrypted data on the optical disk. The Applicant respectfully asserts the claims 11 and 25, as amended, are enabled by the specification of the present application, (*see* Present Application, p. 11, l. 31- p. 12, l. 40 and Figure 10). Briefly, the aforementioned portion of the specification describes that both the encrypted data and unencrypted data are sent to the cryptoprocessor and, subsequently, decrypted (*i.e.*, a decryption algorithm is applied to both the encrypted and no-encrypted data). Further, as discussed by in the specification, once the decrypted unencrypted data has been decrypted (*i.e.*, the decryption algorithm has been applied to the unencrypted data) it is unusable. Finally, the specification notes that such a result is expect and desired to prevent specific types of hacking. In view of the above, the Applicant respectfully asserts that one of ordinary skill in the art would know how to apply a decryption algorithm to unencrypted data. Thus, claims 11 and 25, as amended, are enabled by the specification. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 16, 17, 29-31, 35, and 37 are rejected under 35 U.S.C. § 112, ¶2. The rejection is respectfully traversed. The Examiner has asserted that the term “useful data” is unclear. The term

“useful data” has been removed from all of the aforementioned claims. Accordingly, this rejection is now moot. Accordingly, withdrawal of this objection is respectfully requested.

Rejections Under 35 U.S.C. § 102

Claims 1-5, 7-19, and 35 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,198,875 (“Edenson”). To the extent the rejection applies to the amended claims, the rejection is respectfully traversed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (See MPEP § 2131). The Applicant respectfully asserts that Edenson fails to disclose all the limitations of amended independent claim 1.

Specifically, amended independent claim 1 requires, in part, an optical disk that includes a cryptoprocessor configured to decrypt the encrypted data stored on the optical disk. In contrast, Edenson only discloses the presence of a transponder on an optical disk, where the transponder is configured to store a decryption key but not configured to perform any decryption (*see e.g.*, Edenson, col. 3, ll. 27-25; col. 4, ll. 25-31). In fact, Edenson specifically discloses that the transponder communicates the decryption key to a reader (*e.g.*, a DVD player) so that the reader can decrypt the encrypted data located on the optical disk.

In view of the above, Edenson clearly fails to disclose all the limitations of amended independent claim 1. Thus, amended independent claim 1 is patentable over Edenson. Independent claims 8 and 18-19 are patentable over Edenson for at least the same reasons. Further, dependent

claims are patentable Edenson for at least the same reasons as the aforementioned independent claims.

Rejections Under 35 U.S.C. § 103

Claims 6, 20-34, and 36-37 stand rejected under 35 U.S.C. § 103 as being obviousness over Edenson in view of German Patent DE 4,242,247 (“Ludwig”). To the extent that this rejection applies to the amended claims, the rejection is respectfully traversed.

“To establish a *prima facie* case of obviousness “...the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (See MPEP §2143.03). Further, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” (See MPEP §2143.03). The Applicant respectfully asserts that Edenson and Ludwig, whether considered separately or in combination, fail to teach or suggest all the limitations of amended independent claim 20.

Specifically, amended independent claim 20 requires, in part, (i) an optical disk comprising encrypted data; (ii) decrypting the encrypted data by a portable object using a secret key; (iii) the portable object is located on the optical disk; and (iv) the secret key is not communicated outside of the portable object during decryption of the encrypted data. Turning to the cited references, Edenson, as discussed above, fails to teach or suggest using a device *located on the optical disk* to perform the decryption of the encrypted data. Further, Ludwig does not teach that which Edenson lacks.

Specifically, Ludwig, like Edenson, teaches decrypting the encrypted data using a microprocessor (2) located *external* to the optical disk (*see, e.g.,* Ludwig, Figure 2). In contrast, the

claims require the decryption to occur in a portable object located on the optical disk. Moreover, Ludwig teaches that the decryption key is used the microprocessor. In contrast, the claims explicitly require that the decryption key (*i.e.*, the secret key) is “not communicated outside of the portable object during decryption of the encrypted data.” Clearly, use of the decryption key by the microprocessor clearly violates this explicit limitation.

In view of the above, Edenson and Ludwig, whether view separately or in combination, fail to teach or suggest all the limitations of amended independent claim 20. Thus, amended independent claim 20 is patentable over Edenson and Ludwig. Dependent claims are patentable over Edenson and Ludwig for at least the same reasons.

Further, amended independent claims 1 includes similar patentable limitations as amended independent claim 20 and, thus, is patentable over Edenson and Ludwig for at least the same reasons as amended independent claim 20. Thus, dependent claim 6, which depends from amended independent claim 1, is patentable over Edenson and Ludwig for at least the same reasons as amended independent claim 1.

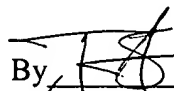
In view of the above, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09669/007001).

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Respectfully submitted,

By,  #45,079
Jonathan P. Osha THOMAS SCHERER
Registration No.: 33,986
OSHA · LIANG LLP
1221 McKinney St., Suite 2800
Houston, Texas 77010
(713) 228-8600
(713) 228-8778 (Fax)
Attorney for Applicant